

PATENT

Docket No. 49933US031 (formerly 49933USA6H)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	HOOPMAN et al.	)	Group Art Unit:	1722
		)		
Serial No.:	09/520,032	)	Examiner:	Joseph Del Sole
Confirmation No.:	9385	)		
		)		
Filed:	6 March 2000	)		
		)		
For:	TOOLS TO MANUFACTURE ABRASIVE ARTICLES			

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OFFICIAL

RESPONSE UNDER 37 C.F.R. § 1.111

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Office Action mailed 30 January 2004 has been received and reviewed. The pending claims are claims 17, 19-21, 25-28, 33-54, 94-96, and 98-111. Reconsideration and withdrawal of the rejections are respectfully requested.

Allowed Claims

Applicants thank the Examiner for notification to the effect that claim 19 has been indicated as allowed.

Obviousness-Type Double Patenting Rejection

Claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23, 254, 30-32, 89, 90, 92, 93, and 133-148 of co-pending Application Serial No. 09/955,604. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

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**The 35 U.S.C. §112, First Paragraph, Rejection**

The Examiner rejected claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner alleged that each of the above-listed claims includes the limitation "wherein each of the cavities has a single opening", which is a new matter limitation not described in the original specification. This rejection is respectfully traversed.

The proper standard to consider in making the present rejection is: "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." (*In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618, (Fed. Cir. 1989). Applicants respectfully submit that one skilled in the art, considering the entire specification, would clearly recognize the Applicants were in possession of the invention as claimed. Applicants respectfully submit that the Examiner has taken too narrow a view of the specification in making the rejection, and that one skilled in the art considering the entire specification would recognize that Applicants did, in fact, possess production tools that included cavities that had a single opening as recited in the claims.

While the original specification does not explicitly preclude the cavity from having more than one opening, as suggested by the Examiner, the drawings do show one and only one opening in each of the cavities. However, "[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." M.P.E.P. § 2163.02. Figures 6 and 7 show representations of the tool. As described in the specification, the production tools may be made using a variety of techniques including, for example, electroforming, casting a polymeric resin, etc. One of ordinary skill in the art would understand that any production tool made using these techniques or similar ones would include cavities that have only a single opening.

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As only one example, various embodiments of production tools are described in the section presented below.

In the event of use of a metal master, a thermoplastic sheet material can be heated and optionally along with the metal master such that the thermoplastic material is embossed with the surface pattern presented by the metal master by pressing the two surfaces together. The thermoplastic can also be extruded or cast onto to the metal master and then pressed. The thermoplastic material is cooled to solidify and produce the production tool.

Specification, p. 28, line 30 to p. 29, line 4.

In the case of a production tool made from a thermoplastic sheet, extruded thermoplastic, or cast thermoplastic as described above, the Examiner has failed to provide any reasoning or evidence as to how or why one of ordinary skill in the art would not recognize that any cavities in such a production tool would not have only a single opening.

To sustain this rejection the Examiner has the burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *In re Wertheim* 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). Such evidence or reasoning is required for a proper rejection under Section 112, first paragraph. *See, e.g.*, M.P.E.P. §2163.04. Failure to provide such evidence or reasoning makes it impossible for Applicants to completely and properly address the basis for this rejection.

In summary, the proper standard for a "written description" rejection is whether or not the specification indicates to one of ordinary skill in the art that the Applicants had possession of the invention as claimed. At a minimum, the limited portions of the application discussed above indicate that one of ordinary skill in the art would recognize that Applicants did, in fact, possess the claimed invention at the time of filing. Applicants respectfully submit that claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 do satisfy the requirements of §112, first paragraph. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

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**The 35 U.S.C. §102 Rejection**

The Examiner rejected claims 25-28 and 94-96 under 35 U.S.C. §102(b) as being anticipated by Rochlis (U.S. Patent No. 3,312,583). The Examiner also rejected claims 20, 21, 33, 34, 36-45, 47-54, 98-, 99, 101-106, and 108-111 under 35 U.S.C. §102(b) as being anticipated by Rochlis (U.S. Patent No. 3,312,583). This rejection is traversed. Previous arguments regarding the teachings of Rochlis made in the Amendments, Responses, and Appeal Briefs are incorporated herein by reference. Further arguments are provided below with respect to the Examiner's "Response to Arguments" as presented in the present Office Action.

**The 35 U.S.C. §103 Rejection**

The Examiner rejected claims 17, 20, 21, 33-54, and 98-111 under 35 U.S.C. §103(a) as being unpatentable over Rochlis (U.S. Patent No. 3,312,583). The Examiner also rejected claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 under 35 U.S.C. §103(a) as being unpatentable over Rochlis (U.S. Patent No. 3,312,583). This rejection is traversed. Previous arguments regarding the suggestions of Rochlis made in the Amendments, Responses, and Appeal Briefs are incorporated herein by reference. Further arguments are provided below with respect to the Examiner's "Response to Arguments" as presented in the present Office Action.

**Rebuttal to "Response to Arguments"**

The prior art rejections presented in the Office Action are based on the Examiner's interpretation of portions of the primary reference (i.e., U.S. Patent No. 3,312,583 to Rochlis). For the reasons presented below, Applicants traverse that interpretation and show that it cannot form the basis for proper rejections under either 35 U.S.C. §§ 102 or 103.

Before addressing that interpretation, however, Applicants traverse the assertion that "the vent openings do not perform any shaping function and thus are NOT part of the molding cavity" because that assertion is not supported by the cited references. Applicants respectfully request that the Examiner provide some basis for the assertion that no mold material would flow into the

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vent openings. In the absence of such a showing, the assertion that mold material would not flow into the vent openings must be retracted because it is clear that some fluids (e.g., air or other gases) do flow into such openings. It would, therefore, seem equally clear that some mold materials with the proper characteristics (e.g., viscosity, etc.) could also flow into such openings.

As for the Examiner's interpretation of Rochlis, it is asserted in the Office Action that "Rochlis (col. (sic) lines 40-46) discloses that "most embodiments" permit air or other evolved gas to escape, and Rochlis (col. 13, lines 70-75) discloses that evolved air or other gas 'may' escape between mating surfaces of the laminated layers. Thus, in the embodiments (in opposition to 'most embodiments') where there are no openings to permit air or other evolved gas to escape, each cavity has a single opening." Office Action, p. 10 (January 30, 2004). These assertions and the conclusions drawn from them are not supported by the reference itself.

With respect to the Examiner's assertions based on the phrase "most embodiments," Applicants note that the phrase "most embodiments" could just as likely be construed to distinguish between constructions in which the notches or cavities extend through the width of the mold laminae as opposed to constructions in which the mold laminae are beveled or tapered as seen in FIG. 8. The relevant portion of Rochlis is provided below.

A further object is to provide an improved method, and laminated disc equipment for practicing the same, in which the molding notches or cavities of most embodiments, extending as they do from side to side of the mold laminae (and in some cases through the thickness of the molded sheet), permit air or other evolved gas to escape during the molding or forming phase. It is therefore not trapped in the mold cavity in a manner to possibly alter the shape or size of the pile elements, which are therefore uniformly perfect throughout the pile area.  
Rochlis, col. 3, lines 40-49.

In other words, in most embodiments, the notches or cavities are formed through the thickness of the mold laminae, but that is not the case in all embodiments. Under this interpretation, the benefits of air or gas escaping are not limited to only "some embodiments" of the Rochlis invention.

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Such an interpretation is more consistent with the remainder of the teachings of Rochlis. Although it is asserted that Rochlis does not require constructions in which air or gas escapes through gaps in the mold laminae, that assertion completely ignores the following section of Rochlis that clearly indicates that all embodiments allow for the passage of air or gas out of the mold cavities.

An important aspect of the present invention, in regard to method and apparatus, resides in the fact that the assembly of a lamination of notched mold plates permits air or other gas to escape during the molding and setting operation. Thus, there is no possibility of such gas accumulation tending to mar the individual outlines of the pile elements or components, in any embodiment of the product. It follows that the latter is uniformly perfect in regard to the contour and size of its individual pile members, whatever such size and shape may be.

Rochlis, col. 14, lines 19-28 (emphasis added).

In view of the above teachings of Rochlis, the assertion that because "Rochlis (col. 13, lines 70-75) discloses that evolved air or other gas 'may' escape between mating surfaces of the laminated layers" means that other embodiments exist in which air or gas cannot escape is not supported by a reading of the whole reference.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP § 2141.02, p. 2100-122, 8<sup>th</sup> Ed. (Rev. 1, Feb. 2003) (emphasis in original) (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Applicants respectfully submit that proper consideration of the teachings of Rochlis "as a whole" leads to the conclusion that the assertions on which the asserted anticipation rejection and *prima facie* case of obviousness are based are not supported by Rochlis itself.

Furthermore, although Applicants have consistently noted that Rochlis does not affirmatively teach any embodiment that includes cavities that do not include openings to allow entrapped air or other gas to escape during molding, the Office Actions have failed to address this complete lack of any affirmative disclosure supporting the Examiner's position. In view of

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all of the above, it seems clear that no such disclosure exists because Rochlis did not conceive that such a mold could be used in connection with the disclosed invention.

Finally, it should be noted that when establishing a *prima facie* case of obviousness, "the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not." MPEP § 2142, p. 2100-124, 8<sup>th</sup> Ed. (Rev. 1, Feb. 2003) (emphasis added).

In other words, it must be proven that the interpretation offered in the Office Actions by the Examiner is more likely to be the correct interpretation than that offered by Applicants.

Applicants respectfully submit that this burden has not been met in connection with the rejections set forth in this Office Action.

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It is respectfully submitted that the pending claims 17, 19-21, 25-28, 33-54, 94-96, and 98-111 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for  
HOOPMAN et al.

By

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29 APRIL 2004

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**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29th day of April, 2004, at 3:12 p.m. (Central Time).

By: Rachel Gaylini-GabaraName: Rachel Gaylini-Gabara